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SUPREME COURT

—OF THE—

UNITED STATES,

No. 202.

On Appeal from the Circuit Court for the Southern District of Ohio.

JOHN W. GOSLING, *Appellant,*

vs.

JOHN ROBERTS, *Appellee.*

In Equity.

ARGUMENT ON BEHALF OF THE APPELLANT.

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ARGUMENT ON BEHALF OF THE APPELLANT.

This suit was instituted in the Court below by the appellant, John W. Gosling, against the appellee, John Roberts, praying, among other matters in relief incident to suits of this character, that he might be restrained from infringing certain Reissued Letters Patent issued to the appellant for a new and useful improvement in carriage building, described in those Letters Patent as a *Combined Step-Cover and Wheel-Fender.*

The answer of the appellee, stripped of its formalities, states a two-fold defense: 1. That the appellee has not infringed the Letters Patent of the appellant, and 2. That the appellant was not the original and first inventor of the improvement claimed in his patent. The appellee also states other matters, which are, in a measure, corollaries of the two main defenses, and which we propose to argue in connection with them, to wit: That the Letters Patent, as reissued, are too broad, and therefore void; and further: That the improvement claimed is neither new nor useful.

There is a formal replication to the answer of the appellee, traversing generally the material allegations thereof.

Upon a hearing below, the Court found the equities of the case to be with the respondent, and dismissed the bill with costs. From this decree the complainant below brings this appeal.

I.

AS TO THE DENIAL OF THE INFRINGEMENT.

The improvement of the appellant, as stated in the specification annexed to Letters Patent Reissue number 5,644 (Record printed p. 54), upon which the suit is founded, "consists in a cheap and simple device for preventing the accumulation of mud and dust on the steps of carriages, etc., and also for guarding the cloth s of the rider from coming in contact with the wheels on entering or leaving the vehicle." * * * * (pp. 54 and 55). "The important feature of my invention is the plate attached to the door of the carriage, and operating *by reason of such attachment* as a step-cover when the door is closed, and as a wheel-fender when it is open."

And the claim made, so far as the present suit is concerned, is (p. 55): "1. In combination with the step D and the door C, the plate E attached to the door, to operate as a step-cover when the door is closed, and a wheel-fender when

the door is open, substantially as and for the purpose specified."

It is in the proof that the respondent used a device "substantially for the same purpose," (and we claim in infringement of the complainant's Letters Patent), under color of certain Letters Patent No. 90,584, issued to him for an invention described by him in his specification (Record, p. 52).

"This invention relates to a cheap and simple device for keeping the steps of carriages clean, and also for preventing the clothes of persons from coming in contact with the rear wheels on entering and leaving the carriage." And the claim of the respondent is stated to be (Record, p. 53): "The combined arrangement of the flexible fender G, attached and strengthened at its upper end (to the door,), the guards or cushions IJ, and steps DEF, all constructed to operate as and for the purposes set forth."

Models of the two devices are in evidence, as Exhibit 1, of complainant.

Model A is the complainant's invention.

Model B is the respondent's infringement.

Argument seems hardly necessary to show that the respondent's device is an infringement of the Letters Patent as reissued to the complainant, so strikingly are the two models alike, in all the material elements of the invention described in the complainant's specification. They both consist in a flexible plate, attached permanently to the door of the carriage, so as to cover the step, and so contrived that the opening of the door will carry the plate into a position fending the wheel of the vehicle.

Besides, the testimony upon this point is conclusive (See Record, Milward, Ans. 5, p. 15; Gosling, Ans. 12, p. 17). The respondent's testimony concedes that the only difference between the two devices is a detail of constsuction. *Curtis* (Ans. 15, p. 23). "This step-cover [Model A] would not be complete without being attached to the step, in my

opinion, or would not be practicable. The only disadvantages I know, is that it contracts the space in getting [in], as shown in contrast with Model B."

Albrecht (Ans. 17, p. 27). "The difference between A and B, A being loose on the door, or operated by hinges on the door, also by hinges on the bottom of the step. Model B, the flexible plate being fastened solidly to the door, and having a guard for the wheel."

Miller (Ans. 10, p. 41). "In the Model A the step-cover is hinged to the door and also to the step; in Model B the step-cover is fastened rigidly to the door, and is not attached to the step; in Model B there is a handle to the door, and in Model A there is none; there is a rubber guard on Model B, upon the cover, to keep it from the wheel, and none in Model A."

If the invention of the complainant is accurately described in the claim of his Reissued Letters Patent (p. 55), it is clear that these details, which are merely mechanical differences of construction, can not affect his rights. And this, we presume, notwithstanding his formal denial, the appellee admits in effect, because the main argument adduced to make the first defense good, is one based upon the invalidity of the reissue.

We admit the statement of law made by counsel below, in his argument. "If the claim of the reissue is broader than the invention, the reissue is void, because it is not for the same invention as the patent which was surrendered as the foundation of the reissue."

Goodyear v. Providence Rubber Co., 2 Fisher, 499.

But this rule must be applied as limited, by Mr. Justice Clifford, in the same case (p. 512). "Rule '*ut magis valeat quam pereat*,' is applicable to patents as to any other instruments, in regard to which it is the duty of the Court to adopt a liberal construction in order to give effect to the intention of the parties: *Ryan v. Goodwin*, 3 Sumn. 520; *Evans v. Eaton*, 3 Wheat., 512."

We also admit, that "the decision of the Commissioner, in cases of Reissue, is not conclusive, *if it appears on the face of the two Patents*, by comparison, that the Reissue is *for a different invention* from that *sought, or thought to be secured, or suggested, or indicated*, in the original Patent."

We have inserted the italicised words instead of the simple word "secured," which was used below in the argument for the respondent, not only because they conform to the law on the subject as laid down by both the Circuit Courts and the Supreme Court of the United States, but, also, because, as we think, common sense requires such a modification. If the precise invention which is to be secured by the Reissue was *secured* by the original Patent, there could be no cause or reason for obtaining a Reissue; the only object of Reissue being to secure to the inventor the invention, which, by reason of the indefiniteness, insufficiency, errors, or other imperfections of the original Patent, although in fact invented, has not been secured by the original Patent.

We think the authorities will bear us out, in stating the law to be that where an invention is described in the original specification either inaccurately, or ambiguously, or in conjunction with other inventions not necessary to its practical utility, a reissue will be valid which corrects that inaccuracy or ambiguity, or which separates the conjoined inventions, protecting each as a distinct one; and in such cases the decision of the Commissioner is final and conclusive. In other words, if the invention which is the foundation of the reissue is included in the original specification, whether it be clearly described, or claimed singly, or not, the Reissue is valid.

"Where a patent claims a combination of several devices, it may be reissued to claim the devices separately, if new and useful, even though the aggregate combination claimed in the original patent was not, by itself, useful, or was even impracticable, provided the reissue points out how the devices separately claimed may be reduced to practical use."

[Syllabus in *Wheeler* vs. *Reaper & Mower Co.*, 10*th Blatchford, C. C. R., p.* 181, *Sept.* 1872, *Woodruff, J.*, and see remarks of Court on *page* 187.]

"A patentee whose devices are new, is at liberty to claim each, by way of reissue, although he may have represented and claimed them ordinarily as acting conjointly."

[Syllabus in *Gallahue* vs. *Bennett*, 10*th Blatchford, C. C. R., p.* 232, *Dec.*, 1872, *Woodruff, J.*]

In this case the Court says, on page 237, speaking of the use by respondent of a *spring alone*, while the *original* Patent of the complainant claimed only a spring and a weight acting conjointly:

"But in my judgment, even if an improvement, it is an infringement. It is an appropriation of a substantial part of the actual invention shown in the original record. Nor do I perceive any sound objection to allowing the inventor, in his Reissue, to claim the action of the spring alone. It is shown in the record of his Patent; and, surely, a patentee, whose devices are new, is at liberty to claim each, by way of reissue, although he may have represented and claimed them originally as acting conjointly."

As to the use and purpose of a reissue, the Court, Blatchford, J., in the case of the *Eickemeyer Hat Blocking Machine Co.* vs. *Pearce*, [10*th Blatchford, p.* 403, *Jan.*, 1873,] says:

"There is no more warrant for saying, in this case, that Eickemeyer did not intend, in taking out his original patent, to make such claims as the second and third claims of the reissued patent, than there is in every case of a reissue, for saying that claims in the reissue, not found in the original, were not intended to be made, when the original was taken out, because they were not put in, as claims, into the original. On this principle there never could be a *reissue covering claims not substantially found, as claims, in the original.*"

The Supreme Court of the United States, in the case of *Seymour v. Osborne*, [11*th Wallace, p.* 516], says:

Syllabus.—"The act of the Commissioner in accepting

a surrender and granting a reissue is final and conclusive, and not reexaminable in a suit in the Circuit Court, unless it is apparent upon the face of the patent that he has exceeded his authority, or that there is such a repugnancy between the old and new patent that it must be held as a matter of *legal construction* that the new patent is not for the same invention as that embraced and secured in the original patent."

And on page 544, Justice Clifford says:

"Power is unquestionably conferred upon the Commissioner to allow the specification to be amended if the patent is inoperative or invalid; and in that event to issue the patent in proper form; and he may, doubtless, under that authority, allow the patentee to redescribe his invention, and to include in the description and claims of the patent not only what was well described before, but whatever else was suggested or substantially indicated in the specification or drawings which properly belonged to the invention as actually made and perfected."

And in a late case, *Marsh v. Seymour*, 7 *Otto*, *p.* 348, this Court, by the mouth of Mr. Justice Clifford, has fully described the uses and extent of a reissue (pp. 355-6).

"Patents in a proper case may be surrendered and reissued, but the reissued patent must be for the same invention as the original patent, else the reissue is invalid; but the patentee may redescribe his invention, and include in the description and claims of the specification not only what was well described before, but whatever else was suggested or substantially indicated in the old specification, drawings, or Patent Office model, which properly belonged to the invention as actually made and perfected. Corrections may be made in the description, specifications or claims of the patent, where the patentee has claimed as new more than he had a right to claim; or where the description, specification, or claim is defective or insufficient; but he cannot, under such an application make material additions to the invention, which were not described, suggested, nor substantially indi-

cated in the original specification, drawings, or Patent Office model."

Applying these rules to the case at bar, we will show that the first invention claimed in the Reissued Letters Patent of the appellant (the only claim involved in this suit), was "suggested or substantially indicated in the old specification, drawings, etc." and "properly belonged to the invention as actually in use and perfected."

The drawings and description of the invention are stated in the specification of the Reissue as follows:

(Record, p. 54.) A represents the body of the carriage, B the rear wheel, C the door, and D the step; E is a plate which may be made of sheet metal or other suitable material, and the upper end of said plate is hinged *or otherwise secured* to the door C. * * * * When the door C is shut the plate closes over the step D, and prevents the wheel from throwing dirt over the step, as clearly shown in Fig. 2; but as soon as the door is opened, the cover and fender E, being attached to the door C, is of course carried with the door, and thus the step is uncovered, and the plate E then occupies such a position as to enable it to serve as a fender to prevent the rider's clothes, on entering or leaving the carriage, from coming in contact with the hind wheel of the carriage, as represented in Fig. 1. * * * * I claim: 1. In combination with the step D and the door C, the plate E attached to the door, to operate as a step-cover when the door is closed, and a wheel-fender when the door is open, substantially as and for the purpose specified."

This invention, upon which the Reissue is founded, as described in the specifications, and illustrated in the drawings of the original patent No. 62,406, is as follows:

(Record, pp. 48, 49.)

A represents the body of a carriage, B the rear wheel, C the door and D the step; E is a yielding plate which may be made of sheet steel or other suitable material, and the upper end of said plate is hinged or *otherwise secured* to the door

C, whilst its lower end is connected to a bar H, having an eye *h*, which engages with a suitable aperture in the flange *d* of the step. This provision of the perforated flange *d* and eye *h* enables the plate E to turn in either direction as the door C is opened or closed. The flexibility of the plate E enables it to bend up in the act of opening or closing the door (see dotted lines in Fig. 1) and its elasticity enables it to hold the door firmly in either the closed or wide open position; when the door C is shut, the plate E closes up over the step D, and this prevents the wheels from throwing dirt upon said step, as clearly shown in Fig. 2, but as soon as the door is opened the plate E turns on the pivot device *d h* at its lower end, thus uncovering the step and serving as a fender to prevent the occupant's clothes from coming in contact with the hind wheel of the carriage, as represented in Fig. 1. The yielding plate E acts as a spring to hold the door either open or shut, and also prevents said door from striking against the wheel when opened. The said plate E may be covered with leather or painted, or may consist wholly of leather. I have selected for illustration the preferred form of my invention, but reserve the right to vary the same, it being susceptible of various modifications; for example, instead of being pivoted to the step D, the lower end of the plate E may be hinged or otherwise coupled to a frame projecting from the carriage and passing under the step. In some cases, for example, when the distance from the wheel to the body is short, I provide slots on both step and fender, or one of them, to partially or wholly relieve the plate of the flexion incident to opening or closing the door."

"I claim herein as new and of my invention a combined step-cover and wheel-fender for carriages, consisting of the flexible plate E, whose upper end is attached to the carriage-door, and whose lower end is connected *d h* to the step or other fixed object, the whole being arranged to operate substantially as herein described and for the purpose set forth."

A candid study of this specification will convince any one, at all familiar with carriage building, that it is composed of two entirely distinct devices; the first—being a plate, so attached to the door as to cover the steps when the door is closed, and to cover the wheel when the door is open, and the second—a plate of flexible material, so connected with the steps, as to enable it, by means of its elasticity, to hold the door firmly in either its closed or open position. The first is a combined step-cover and wheel-fender; the second a spring fastener. And although the two devices are described together, and no separate claim is made of each device distinctly, neither is necessary to the practical working of the other, as the combined step-cover and wheel-fender might well be attached to a door, fastened in any known manner, and the elastic fastener might well be connected with the step of a carriage, sufficiently long-coupled not to require a wheel-fender, or sufficiently high swung not to require a step-cover. Each invention is separately useful and practical, although it may be convenient to use them in combination.

That the action of the spring was not, at the time of the original patent, considered by the appellant as a necessary element of the combined cover and fender is manifest from this language in the specification, (Record, p. 49). "The plate E may be covered with leather or painted, *or may consist wholly of leather.* What becomes in that case, of the spring action of a sheet of metal? Again the specification says(p. 49)." In some cases, for example, when the distance from the wheel to the body is short, I provide slots on both step and fender, or one of them, to partially or wholly relieve *the plate of the flexion incident to opening or closing the door.*" We can hardly see, in such a case, what essential part of the invention, the action of the plate, as a spring, can subserve?

But the claim was so limited, in the original patent, that neither of the new inventions contained and described in the specification, were properly secured, except in combination, and

for the better securing of both, a Reissue was obtained. It is submitted the case at the bar is all fours with *Gallahue and Bennett* 10 *Blatch. C. C. R. p.* 232; that it is the case of a patent so defective as not to secure to the inventor what he had really invented "as suggested and substantially indicated in the old specification, drawings, etc.," and that it is exactly such a case for which the law provides a remedy by way of Reissue, in the light of the authorities above quoted.

It seems to us that all this is sufficiently clear from the Patents themselves, but to relieve us of any possible embarrassment on this point, counsel for the respondent has called out the testimony, which shows, beyond all question, that our view of the invention and the view of the Commissioner, as shown by the Reissue, is in fact the correct one, and conforms to the real facts and history of the case.

In the cross-examination of Mr. Gosling, beginning on page 18 of the printed record, in answer to questions put to him by counsel for the respondent, the inventor says the object of the Reissue was to perfect the Patent so as to get in a claim for what he had really invented; that the invention was in fact a plate acting at the same time as a cover and as a fender, which was something entirely new, and that he supposed the first claim of the Reissue and the one claim of the original Patent covered this broad invention.

From this we see that in truth and in fact the complainant did make this invention, and that, unless the Reissue be sustained, he is to be deprived of those benefits of his invention, to which he is entitled, because of a defective Patent, which did not in law cover what the inventor in fact intended that it should and believed that it did, although clearly indicated in the specification.

We submit that the Reissue in its liberal, and as we think, in its only construction, should be sustained.

II.

AS TO THE ORIGINALITY OF APPELLANT'S INVENTION.

We submit that the proof makes a clear case for the complainant, and that the testimony for the defense does not in any manner weaken the claim of the patentee, to be the first and original inventor of a new and useful device.

The complainant offers his Reissued Letters Patent, from which it appears that Letters Patent were originally issued to him, dated February 26, 1867, and that, afterwards, they were surrendered and canceled, and then Letters Patent ordered to issue on an amended specification, which was accordingly done.

It appears from the specifications that the Patent is for a COMBINED STEP-COVER AND WHEEL-FENDER for carriages, to prevent the accumulation of mud and dirt on the step, when the door is closed, and to protect the clothes of the rider from coming in contact with the wheel on entering or leaving the carriage. The contrivance is a very simple one and yet quite novel in its character, as will be seen from an inspection of the Letters Patent, with the drawings which form a part of them, and of the working models, (*Exhibit 1 Model A and B,*) introduced in evidence by the complainant. A thin plate of metal or leather is attached to the door in such a manner, that, when the door is closed, it shuts tightly upon the step and the brackets which support the step, and, when the door is opened, this same plate takes a position directly in front of, and in a line with the tire of the hind wheel, so that the clothes of the rider cannot, by any possibility, brush the wheels.

This is, in fact, the invention of the patentee, as embodied in the first claim of the Letters Patent (Record p. 55.)

The testimony offered in support of complainant's Patent, to show the novelty and usefulness of this invention is not of great length, occupying only twelve pages of the Record, but it is clear, decisive and directly in point.

Frank Milward, a mechanical engineer and expert of the very highest reputation for ability, experience and integrity, explains more fully, by his testimony, that, which would seem to be sufficiently plain from the reading of the Patent itself and bears witness to the originality of the device. (Record pp. 13, 14, 15.)

John W. Gosling, the complainant, also explains the character and extent of his invention, and identifies the two models *A* and *B* as being correct representations of the improvement secured by his Patent. Mr. Gosling, after establishing his qualifications as an expert in the matter, testifies that no *combined* step-cover and wheel-fender was known or used before his invention, (Record, p. 17 Ans. 8,) and we think that all the the testimony in the case goes to bear out his assertion, and with such force, that no doubt of its truth and correctness can be entertained.

George R. Groot, also a carriage maker, and showing himself, by his testimony, well qualified in the matters about which he testifies, confirms the statement mady by Mr. Gosling, that, up to the time of Gosling's invention, no *combined* step-over and wheel-fender was known or used. (Record, p. 19, 20, Ans. 6.)

This is all the complainant's testimony on this point. Then comes an exhaustive examination, by learned counsel, of many witnesses, called by the respondent, mainly to show that the complainant's device was "weary, stale, flat and unprofitable," and had been common property for years.

Although, in our opinion, the testimony of these witnesses, without cross-examination, could, in no way, weaken the claim of the complainant, yet one or two of them have been cross-examined at considerable length, not merely for the purpose of showing the weakness of the attack upon the novelty of Gosling's invention, but also for the purpose of showing the spirit of the witnesses, and we think, in some cases at least, it has been made apparent.

We beg the Court to notice one thing particularly.

Gosling obtained his original patent in 1867. There is no proof, *nor any attempt to prove*, that a combined step-cover and wheel-fender of this kind (a simple plate) was ever known or used, until Gosling took out his patent. In fact, the witnesses for the respondent impliedly admit that, up to that time, no *such* combined cover and fender was known or used. (*See testimony of Curtis, p.* 22, *Ans.* 3; *of Albrecht, p.* 26, *Ans.* 3; *of Miller, p.* 40, *Ans.* 3; *and of Ransom, p.* 44, *Ans.* 4).

Yet not only do we find Mr. Roberts infringing on this Patent, and seeking to protect himself under a *subsequent* patent of his own, but the witness, Mr. Curtis (*p.* 23, *Ans.* 31, 32 *and* 33.) has since that time been using a similar device; and the witness, Mr. Albrecht, also used a flexible plate, similar in appearance, upon which, it seems, he likewise obtained a patent.—(*page* 30, *Ans.* 45, 46, 47 *and* 48.)

Is not this of itself sufficent commentary upon the testimony by which it is attempted to prove, that the old-fashioned step-cover, which has been used for years, really contained the invention claimed by Gosling?

The defense is that the old-fashioned flat step-cover attached to the door by the rod or stem, is a plate serving the two purposes of a cover and fender. We think this proposition is undeserving of argument. In the first place, this old device is not a plate at all; in the second place, it does not and could not serve the purpose of a fender, nor was it ever intended or used for such a purpose; and in the third place, even if that which is claimed for it were true, it would in no way conflict with or detract from Gosling's invention.

(*See Record, testimony of Curtis, pp.* 22, *Ans.* 5; 23, *Ans.* 7; *and* 24, *Ans.* 26: *testimony of Albrecht, p.* 20, *Ans.* 32, 33, 34 *and* 35: *testimony of Miller, p.* 40, *Ans.* 3, *p.* 42, *Ans.* 15, 16, 17, 18 *and* 19: *testimony of Ransom, p.* 45, *Ans.* 11, *p.* 46, *Ans.* 24 *and* 25.)

But, besides the old-fashioned cover, which is relied on by the defense, two instances, perhaps three, are attempted

to be proved in which a device was used which, it is claimed, embodied the Gosling invention. The testimony as to what is attempted to be proved is very indefinite and unsatisfactory, and, as we think, fails to make proof. It is certainly strange that skilled carriage makers should have seen, so many years ago, this very invention (which has since been made by Mr. Gosling and pounced upon by all his fellows in the trade,) and yet never have used or attempted to use or apply the device in the course of their business; and that too, when two of these witnesses, Mr. Curtis and Mr. Albrecht, are found, shortly after the invention by Mr. Gosling, *using a similar device of their own invention;* and going to the trouble and expense of patenting those devices, although they knew the mechanical principle involved to be stale, and the device not properly the subject of Letters Patent.

However, taking, for the purpose of argument, the proof of these prior devices to be satisfactory, *so far as it goes*, it can yet avail the respondent nothing, for two reasons: first, it does not prove the existence or use of any *practical combined* step-cover and wheel-fender; and second, even if the proof were ample, no *such* device is proved, as has been patented by Gosling, and infringed by Roberts.

Let us take these instances in their order, as testified to:

Mr. Curtis testifies to the use, by a man named Adams, in England, of the device represented by respondent's model No. 1,—a flat step-cover of the old style, but hung to the door by *two* stems, bent into heart shape, these two stems being covered with leather so as to serve as a fender when the door is open. There is no plate forming a combined step-cover and wheel-fender; there is no combined step-cover and wheel-fender at all. The step-cover not only does not act as a fender, but (unless it falls outside of the wheel,) the mud which must and does accumulate on the upper surface, is brought into closer contact with the dress of the rider. The fender, on the other hand, does not, in any wise, act as a step-cover. It has nothing to do with covering the step,

which would be as well covered without it, as with it. In fact, an inspection of the model will show, that mud and dirt must accumulate on the brackets, or supports, of the step to such an extent as to preclude the idea of protecting the dress of the rider at all, as is done in Gosling's invention by the fender, which also acts as a cover. In other words, the device is simply the attaching of a clumsy fender on to the stem of an old-fashioned cover; there is no combined cover and fender, but the cover and fender, each serving no purpose other than its own, are fastened together; much less is there any plate shown which serves the combined purpose of cover and fender.

The next instance in proof brings us upon a witness, who, whatever may be said as to the trustworthiness of his testimony, has entitled himself to special mention, because of the artistic flavor of sensationalism he has managed to give to the single instance he can quote. We refer to Mr. Otting. (Record, p. 36, 37, 38, 39 and 40.)

We ask the Court to examine this testimony carefully, for the purpose of observing its many peculiarties. The carriage to which the alleged device was attached, was seen some sixteen years since; it was seen only once; it cannot be ascertained whether the vehicle was new or old; no one can tell who was the maker, or who, the owner; old man Butler, in front of whose shop it was seen, is dead and there are no partners, associates in business, clerks or workmen of his to be found, nor are the names of any of them, nor even the fact whether they be living or dead known; no one was present when the witness examined the carriage, nor can he give the name of any person who has ever seen it; nothing is known as to where the carriage came from or where it went to, it was never seen, so far as we know, either before or since; in the words of the witness, which he repeats, he "*just passed by*," he cannot tell how the device was attached to the door, he cannot tell what it was made of, or how it was made, he cannot say whether the door had a glass in it or not, nor

whether the step was long or short, nor whether the carriage was short or long coupled; nor how much space there was between the fore and hind wheels; the witness cannot state whether the device fitted close to the step or not, nor whether it was straight or bent, nor whether the step had any protection at the side; and yet the witness says he stopped and examined it, and opened the door "to see how the thing worked." These are some of the peculiarities of this testimony; but there is more.

The witness is a carriage-maker, and has been engaged "in doing the whole work of building the carriage," and we may therefore presume that he knows something about the subject of carriage building. Now he is first asked whether he has ever seen a device which served as both cover and fender, to which he answers in the affirmative, and gives the time and place. Thus the witness is asked to *describe the device in particular* [p. 37, ques. 7) and what does he answer? Why, he says: "SOMETHING LIKE THESE HERE (RESPONDENT'S EXHIBIT, Model 1,) THE TWO BRANCHES OF THE STEM COVERED THE WHEEL AND THE STEP. THE SPACE BETWEEN THE TWO BRANCHES WAS SOLID. THAT IS ALL, TO MY RECOLLECTION."

This would never do, and so the witness is examined on leading questions, until he so completely changes his recollection, that he says there were no stems, or branches of stems, no step-cover that he knows of; that the plate (a word put into the witness's mouth by a question) was kind of crooked, and, to sum up, it was very much like complainant's model *B*, and not stale, like respondent's model *A*. Yet, before the recollection of the witness was refreshed, *with all the models before him*, he selects respondent's model 1, as being the best representation of what he had seen on that carriage. The witness, at first, selected the left-hand model on the wrong exhibit, that's all.

If Mr. Otting, being a carriage-maker and blacksmith, has no better recollection of what he saw, than to testify, first, that it was like respondent's model 1, with branching

stems, and then, in the twinkling of an eye, to turn round and assert that it had no stems at all, and no step-cover, and that it was a solid plate, like complainant's model *B*, it goes to show, either that an interval of sixteen years will befog the most conscientiously inquisitive of carriage-makers and blacksmiths, and make his testimony vacillating, or else, that Mr. Otting does n't know what he is expected to prove, but is willing to learn from counsel; a willingness that may show a very kindly spirit, but we doubt whether it indicates equal safety of judgment. Whichever theory is correct, Mr. Otting's testimony is worthless.

But aside from all this, and aside from the fact that there is no proof whether this phantom step-cover seen by Mr. Otting, was ever used, or that it was fitted for practical use, there is no proof that it was *a combined step-cover and wheel-fender*, or that it was used as such, or that it was intended for that purpose; and the witness did not examine it in that light. This appears from answers to questions 38, 39, and 40, which make it uncertain whether the "*plate*" fitted close to the stays of the step, or whether the step had anything in the nature of protection on its sides.

Mr. Ransom also testified [p 45, Ans. 11, 12, 17 and 18] that his impression is that he once saw an omnibus step-cover, on a thorough-braced coach, but that he cannot recollect distinctly about it. He says it acted as a step-cover, and *might have been made* to act as a wheel-fender, but that he has no recollection as to whether it was intended to serve as a wheel-fender, or whether it did serve as a wheel-fender, his "mind not being at that time on wheel-fenders." It may be well to state, in this connection, that as no protection is necessary to keep the rider's clothes from brushing the wheels of omnibusses, since the wheels are in no proximity to the door, it seems improbable that any omnibus step-cover can have had combined with it an absolutely unnecessary precautionary device.

We hardly think this, and kindred testimony, needs any comment.

There is only one other attempt upon the novelty of of Gosling's invention, and that is through Ashenfelder's patent, issued in 1852, for an IMPROVEMENT IN OMNIBUS STEP PROTECTOR. There is nothing in this patent, so far as we can see, which has any bearing on the case. Ashenfelder invented a protector for omnibus steps, for the purpose of "*keeping boys and others off the same*," with which he combined a brush, attached to the protector, which brush swept the step clean whenever the door was shut or opened. Ashenfelder claims the combination of the protector with the brush or brushes. There is no wheel-fender, no need for a wheel-fender, and nothing which serves as a wheel-fender. There is no step-cover for preventing mud from getting on the steps, but brushes are provided to sweep it off every time the steps are used. And last, but not least, there is no attempt, even at the combination of a step-cover and wheel-fender,

We have now considered every question in the case, except the one which is indicated in the answer, as to the reissuing of Gosling's patent, for the purpose of including in it inventions not made by him, to the end that he might harass his neighbors with lawsuits. We see nothing whatever upon which to base such assertions; but knowing, as we do, the great ability and ingenuity of the counsel for the respondent, we shall wait until we have learned upon what foundation the argument rests.

Before closing, we wish to say a word or two upon the spirit of the witnesses for the defense, as manifested in their testimony. Perhaps, upon reflection, it will seem but natural that a witness has, unknown to himself, a leaning towards the cause of the party for whom he is testifying, and that, while anxious to be perfectly fair and honest he unconsciously favors one side of the case. But there are cases in which the witness so palpably attempts to testify to everything which may aid the

one side and keep back and evade everything which might, by any possibility, aid the other side, that his testimony becomes worthless. An instance of this is to be found in the testimony of Mr. Albrecht, in this case, he being one of those who have gotten a subsequent patent. The evidences of this are so numerous that it would only be confusing to attempt to point them out, and we must ask the Court to examine the testimony of Mr. Albrecht on cross-examination, for the purpose of seeing how unwilling the witness is, to testify to the truth. Albrecht is a carriage-maker, and he is examined exclusively upon the subject of carriage building. He is unwilling to state and evades stating the average size of the stem of old-fashioned step-covers, or whether the device shown in model 2, is generally applied to certain classes of carriages, or whether the purchase of the covers from Gosling was before or after he got his patent, or in what position, with reference to the door space, the step is usually hung. When further cross-examined on this last point, the witness talks about a space of *three feet* between the body of the carriage and the wheel, which would make the tread or track of the carriage *six feet without allowing anything for the body*, and if we allow only three feet for the body, we should then have a carriage with a *nine-foot* track, when the state track is only five feet two inches; that is, a carriage nearly double as wide as the regulation. The answers of the witness immediately following this statement, show that he knew when he made it, that it was absurd; yet he did make it, simply to avoid admitting that in some cases, model No. 2, could not be conveniently applied. He also evades admitting that there is a difference in the length of the step (distance from step into carriage) in different classes of vehicles, and that the longer the step, the further it must project or stand out from the body of the carriage, in order to make the step convenient. These are well known facts, but the effect of them would be to show that the stem of a step-cover, such as is shown in re-

spondent's model 3, must curve outward, and, when the door is open, backward, so that the curve falls not only outside the wheel, *but also behind it*, and Mr. Albrecht does not, therefore, want to testify to these facts. He now makes another absurd statement as to a step *twenty-four inches long*. If we take Mr. Albrecht's statement [on page 35] as to the size of the hind wheel, this would put the step above the line of the hub, and the bottom of the carriage above the top of the hind wheel. The witness afterward admits that no such step was ever used. He can not be induced, however, to give even an approximate statement as to the greatest or the least space left between the body and the wheel, in the widest or narrowest carriage bodies used; had he done so, it would have shown many of his statements to be absurd, as well as untrue.

But we have devoted more time to this subject than we had intended. The proof itself is the thing of chief importance, and not the spirit of the witnesses.

And we fail to see in the proof a *scintilla* of evidence to contradict the positive evidence for the appellant, that this invention was new and useful, and that the appellant was the first and original inventor.

We deem it unnecessary, to examine in argument the Exhibits 1, 2 and 3 offered by the respondent below. No argument of ours can be half so damaging to their value as evidence, as they are themselves, when examined in comparison with complainant's models A and B.

We have, in our line of argument, endeavored to meet the able presentation of the defense which our learned opponent made to the Court below, and have not seen the brief prepared for the consideration of this Court. Should any new points be made in the present argument, for the appellee, we ask permission to answer them briefly.

Respectfully submitted.

Jan. 12, 1882.

C. N. Bruce

Of Counsel for the Appellant

16-39

No. 202. October Term, 1881.

SUPREME COURT OF THE UNITED STATES.

JOHN W. GOSLING,

Appellant,

VS.

JOHN ROBERTS,

Appellee.

APPELLEE'S BRIEF.

WM. HUBBELL FISHER,
FOR APPELLEE.

Allen Collier, Printer, 53 East Fourth St., Cincinnati, O.

Supreme Court of the United States.

OCTOBER TERM, 1881. No. 202.

JOHN W. GOSLING, Appellant.

vs.

JOHN ROBERTS, Appellee.

APPEAL FROM CIRCUIT COURT FOR SOUTHERN DISTRICT OF OHIO.

APPELLEE'S BRIEF.

Combined step-covers and wheel-fenders were well known and in constant use prior to complainant's invention.

The testimony shows that the device represented in Model No. 1, was in public use in London, England, thirty-five years ago, and that it was constructed and arranged to operate both as a wheel-fender and step-cover, and did so operate. The testimony further shows that the device shown in Model No. 2 was in use in this country thirty-five years prior to March 13, 1877.

See testimony of John Curtis, Ans. 3 and 4 and 5, pp. 22 and 23, of Supreme, Court Printed Record.

Ans. 5 & 11, pgs. 22 & 23 of Record.

Ans. 11, pg. 23 of Supreme Court Printed Record.

John Curtis, carriage manufacturerer of this city, testifies that he himself made and used same in this country from ten to fifteen years prior to March 13, 1877.

Ans. 8 same pg. X ans. 26, pg. 24.

It also appears that this device was formerly used on light and high swung vehicles, and is now also used on heavy carriages swung low.

Ans. 5, pg. 22, ans. 6, 7, 8, 9 and 10, pg. 23.

Curtis testifies that the step-cover is ordinarily arranged so to operate as to protect the dress from the wheel, while the cover keeps the step free from mud.

Same answers and X ans. 25 and 26, page 24.

Curtis testifies further that in early times, when carriages were hung higher, and the stem of the cover was longer, he arranged this device upon the carriages he made combined so that the stem operated to protect the dress from the wheel, while the cover kept the step free from mud, etc., and that such device operated to successfully accomplish both purposes.

See Albrechts, testimony, pg. 26.

F. C. Albrecht, a carriage maker, who has been in the business since 1849, testifies that he knew of combined step-cover and wheel-fenders, the stem of the step-cover being in front of the wheel, ever since he could remember. He says the device shown in Model No. 2 was commonly used since and prior to 1859. That he has been making such device and applying it to carriages ever since 1859, and considers it a practical device for protecting the dress from the wheel when the door is open, and covering the step when the door is closed. A guard outside the door keeps the stem of step-cover from rubbing against the wheel.

Ans. 110, pg. 36 of Supreme Court Printed Record.

John C. Otting, a blacksmith of carriage work, testifies that he saw the step-cover and wheel-fender combined and attached to a standing-top Rockaway fifteen years ago, on David Street, in Cincinnati. That the same was a solid plate, covering step and wheel. When the door was open at right-angles the plate touched the wheel. His attention was called to the carriage, and he opened the door to see how it worked. He was led to examine and open the door because he had never seen anything before like it.

See Otting's testimony on pg. 37 of said Record.

Also, ans. 15 page 38.

Ans. 35, page 39.

Ans. 10. page 37.

Ans. 46, page 39.

John M. Miller, a large carriage manufacturer of Cincinnati, has been engaged in the business of carriage making for over thirty years. He testifies that he saw device represented by Model No. 3 prior to 1867. That the same is a practical device as a wheel-fender and step-cover, and that he has put same upon carriages.

See testimony of Miller, ans. 4, 5 & 6, page 40.

And H. W. Ransom, who has been largely engaged in the blacksmithing department of carriage manufacture for many years, having learned his trade twenty-seven years ago, testifies that he has known the devices shown in Models Nos. 2 and 3 to be in use as far back as he can recollect, and says that such devices operate as wheel-fenders and step-covers.

See testimony of Ransom. Ans. 4, 5, & 6 pg. 44.

Considerable effort was made by complainant in his cross-examination of respondent's witnesses to show that the step-cover and wheel-fender represented by Exhibit Model No. 2 was not applicable to vehicles short-coupled and with large wheels, but the testimony showed that it was.

Curtis says, ans. 8, page 23, (of Supreme Court Printed Record,) that Exhibit Model No. 2 would operate as a wheel-

fender and step-cover when carriages were hung higher and the stem of the cover was longer.

Curtis says, X ans. 25, page 24, that the step-cover shown in Models Nos. 1 and 2, was applicable to all classes of heavy carriages.

Albrecht says, ans. 8, page 26: Respondent's Model No. 2 is a practical device. X ans. 27, page 28: Respondent's Model No. 2 is applicable to all vehicles that have a door.

X ans. 30, page 29: The question, "how the carriage is hung," has nothing to do with the application of Model No. 2.

X ans. 38 and 39, page 29: Model No. 2 is applied to both high and low hung vehicles, and he has applied it to short-coupled high carriages.

Miller says, ans. 9, page 41: Model B (Roberts' device) is practicable as a fender and cover.

Ransom says, ans. 9 and 10, page 44, and ans 19, page 46: Same objection would not apply to the application of "B" (Roberts' device) to certain short-coupled carriages that I have given with reference to "A," (Gosling's device.)

Ans. 22, page 46: Models Nos. 2 and 3 are applied to all classes of carriages that "A" is. And the testimony showed farther that complainant's device was not applicable to this class of carriages.

Albrecht says, Ans. 15, page 27: Model "A" is not applicable to high wheel, short-coupled carriages. X ans. 27, page 28, Model "A" is not applicable to all carriages. *See note.*

NOTE.—Model "A" represents complainant's patented device.

Ransom says, ans. 9 and 10, pages 44 and 45: Model "A" is not applicable to all classes of carriages. X ans. 20, page 46, Model "A" cannot be applied where other step-covers might be.

It appears from the testimony in the case, confirmed by that common and usual acquaintance with road vehicles which all of us possess, that long prior to February 20th, 1867 (the date of complainant's alleged invention), several well-known devices were in use, each of which served both as a wheel-fender and step-cover.

The plate "E" referred to in complainant's reissued patent differs from the devices seen and in use prior to the date of said patent only in degree and not in any *functional* or *mechanical* points.

COMPLAINANT'S REISSUE IS TOO BROAD, AND THEREFORE VOID.

"If the claim of the reissue is broader than the invention, the reissue is void, because it is not for the same invention as the patent which was surrendered as the foundation of the reissue."

Goodyear v. *Providence Rubber Co.*, 2 Fisher 499.

In *Carhart* v. *Austin*, 2 Fish. Pat. Cases, 543—it was decided that—

"The decision of the Commissioner, in cases of reissue, is not conclusive if it appears on the face of the two patents, by comparison, that the reissue is for a different invention from that secured in the original patent."

"Additions made to the specification, which are neither suggested or indicated in application or model, nor in the

specification or drawings, are mere interpolations and not amendments, and a reissued patent containing them is void."

If we examine closely the original patent, No. 62,406, February 26, 1867, to Gosling, we observe that it is for a single, and so far as we can observe, a novel invention. The patent is not for *any* combined step-cover and wheel-fender (for such a combined device was old), but for a combined step-cover and wheel-fender made in a peculiar manner, viz: by taking a flexible elastic piece of sheet-metal, of the desired size, *attaching one corner* of this metal to one corner of the step, or a frame of the step, and securing the upper edge of this same piece of sheet-metal to the bottom of the door by hinging, or otherwise securing it to the door. Now, it is evident that the patentee did not in his original patent contemplate employing this elastic piece of metal "E" (see his original patent), *when disconnected from the step.* That is to say, he considered his invention to consist in the elastic piece E *when attached to the step. See note.* For his patent says: "Its elasticity enables it (i. e. the plate E) to hold the door in either the wide open or closed position;" and again: "the yielding plate E acts as a spring to hold the door either open or shut, and also prevents the door from striking against the wheel when opened."

See Gosling's original patent, last line on page 48 of Sup. Court Printed Record.

The plate could not perform this function (which, in view of the fact that combined step-covers and wheel-fenders were old, was one of the chief alleged advantages of his invention) without being fastened to the step or a frame below, as the bottom of the plate must have some purchase

*NOTE.—He says in his original patent, (see line 7 from bottom of page 48 of Supreme Court Printed Record, "its (i. e. the step's) lower end is connected to a bar H having an eye, *h*, which engages a suitable aperture in the flange *d* of the step." There are no "ifs" nor "ands" about it.

below or at the bottom in order to be able to *keep* the door shut when closed, and to keep the door open, when opened, as complainant Gosling specified in his patent. In alluding to modifications, of which his invention was susceptible, Gosling *nowhere* in his patent even *hints* that it entered into his mind to employ the plate E when disconnected from the steps or otherwise than fastened at the *lower end*. On the contrary, the only modifications he suggests are those which contemplate a *connection* of the step and plate E. He says: "For example, instead of being pivoted to the step D, the lower end of the plate E may be hinged or otherwise coupled to a frame projecting from the carriage body and passing under the step. *See note* 1. In some cases, for example, when the distance from the wheel to the body is short, I provide slots on both step and fender, or one of them, to partially or wholly relieve the plate of the flexion incident to opening or closing the door." Thus we see the gist of the invention is to connect the flexible plate at bottom to the step, or a rigid frame-work formed for the *special* object of connecting the bottom of the plate to the vehicle.

See Gosling's original patent, line 13 of page 49 of same Record.

The plate E could not incur the flexion, which he makes a necessary incident of the operation of his device, if the plate was not connected to the step. *See note* 2.

NOTE 1.—Complainant's specification takes the trouble to invent a frame-work where the step cannot be employed, in order that the plate may always be fastened at its lower corner.

NOTE 2.—As to "modifications" spoken of in his original patent, at line 12 of page 49 of Record, it can of course refer to and include only those made to carry out the design and specified construction set forth in the patent, and cannot be enlarged to include things or modes of construction foreign thereto. An example of a proper modification is given by the specification, where it mentions the employment of a rigid frame-work to be used instead of the step as a *fastening point* for the flange.

In order to carry out his invention and render the same operative, complainant connects (see his original patent, lines 13 and 14 of page 49 of Supreme Court Printed Record,) the plate E to the carriage *door* by means of a hinge. That he must employ a hinge or other *loose* connection between the door and plate is very evident; because, if the connection were a rigid one, the lower corner of the plate E being confined to the lower step, the plate would always act as a spring to return the door to one position, and thus keep the door continually shut or continually open, either of which tendencies would render the plate a nuisance instead of a convenience, as no person would want the door continually flying open or closing on him while in the act of entering or leaving the carriage. The opening and closing of the door would finally break the plate E off at the junction of the latter therewith. Hence the necessity of having a loose connection at this point of union between the plate and door is obvious.

The invention of the plaintiff, therefore, in order to be operative consists of a flexible plate E connected at bottom to the step or rigid frame-work of the carriage, and at top to the door by a hinge or other loose connection in the nature of a hinge.

The plaintiff's reissue does not differ materially from plaintiff's original patent, except in the following points, viz: First. In the body of the specification it has the verb "*may be*" where the original specification has "*is*." Thus the original specification says: "its (i. e. plate E) lower end *is* connected to bar H, having an eye *h*, which engages with a suitable aperture in the flange *d* of the step." The reissue

says: "The lower end of the combined cover and fender E *may be* connected to the bar H, having an eye, *h*," etc. See his reissued patent, line 6 on page 12 of Supreme Court Printed Record.

If this word "may" be construed to mean that the plate E may be attached to the step *or to a rigid frame-work* projecting from the carriage, which alternative mode of *fastening* the step is alluded to in the text of the original specification, there is no objection to it, but if its presence is to be made a means of construing the patent so as to include a foreign device, viz: a plate E disconnected at bottom from the step, and rigidly fastened to the door, it is submitted that such a construction if permitted would render the reissue void, because it would cause it to include a device and a construction of parts *not shown* in the *model* or *drawings* of the *original* patent, and furthermore, not only *not hinted* at or contemplated in said original specification, but also *foreign* to the device and construction of parts described and claimed and pointed out in said specification to be the invention of said patentee. Secondly. As to the *first claim* of the reissue (not found in the original patent), the same line of reasoning obtains. This claim omits mention that the plate E is attached to the step. If the claim is construed through the words "substantially as specified" to mean that the plate E at bottom is to be attached *either* to the *step* or a rigid *frame-work*, the claim is not broader than warranted by the original specification; but if the claim is construed as covering a flexible plate hinged or otherwise secured to the door and *disconnected* from everything at its *bottom*, then we submit such claim is void, as being for a device and construction not

warranted by the original patent, by either the model, drawings or specification thereof. To illustrate how inoperative the plaintiff's device would be unless the plate E were connected at the bottom to the step or frame-work, let us suppose it were not thus connected. In such a case, the piece E hinged at the top to the door would dangle like a broken limb, and whether the door was closed or open, would flap about, making any amount of distracting noise and bruise everything it flapped against, and likewise be bruised in turn.

In view, therefore, of the state of the art, which shows that a combined step-cover and wheel-fender was known and in use at the time of the plaintiff's invention, and in view of the scope and intendment of the original patent, the reissue, in order to save its validity, is not to be extended to cover any device wherein the gist of plaintiff's invention, viz: the connection between the bottom of the plate E and the step or a rigid frame-work, is absent.

If these positions be admitted as correct, it follows that the respondent's device is not an infringement of the plaintiff's patent.

It is to be observed that respondent's device is nothing more than a thin plate of sheet iron, covering the step when the door is closed and operating as a wheel-fender when it is open.

This plate is rigidly attached to the door (differing in this respect from the plaintiff's device as patented), and it has no connection whatever at bottom with the step or frame-work, or anything else (differing also in this respect entirely

from the plaintiff's patented device). It is therefore a different device. It does not present the alleged advantages derived from the junction of the plate and step or the hinging of the plate to the door, viz: the use of the plate as a spring to keep the door open when open and shut when shut, and the respondent does not care anything about them. Respondent has provided his door on the outside with a rubber guard or cushion so that when the door is open, the guard shall intervene between the wheel and the plate E, and thus save the latter from injury by abrasion against the wheel. See Exhibit Model B. In this respect *he* has shown invention.

Now, if the plaintiff had in his patent intended such a device as the respondent employs, he would, in order to have an operative device, have specified that the connection between the bottom of plate E and the step or frame-work should be absent, and that when this was the case, the connection between the plate and door should be a rigid one; and further, that the back of the plate should be provided with a guard or cushion to prevent abrasion by the wheel.

But the complainant did not mention such device. The truth is he never thought of it until he saw respondent's device, and then he struggled to cover the latter by a reissue, and then employed, as an expert to define his reissued claims, *the same solicitor who obtained the reissue.*

See testimony of complainant's Expert Millward. X ans. 8, page 16 of Supreme Court Printed Record.

A case in point is *Kirby vs. Dodge & Stevenson Manufacturing Co.*, Northern District of New York, December 1872, 6 *Fisher P. C.* 170, where Woodruff, Judge, says:

"In principle, removing a bolt does not differ from adding a bolt; and in the machine described in the original patent that bolt was a mechanical device, performing a precise and defined mechanical office. and, according to the terms of the specification, as it was in fact, indispensable to that office."

"The terms of the original specification are explicit; the front end of the frame is fastened to the upright pieces by bolts, and these bolts are shifted into different holes in these upright pieces to vary the height of the 'cut' of the finger or cutter bar.

After the issue of his original patent, complainant in case cited finding that by not bolting the frame to the upright pieces he could accomplish more advantageous results in mowing, had a reissue prepared so as to enable him to claim the device or apparatus with the bolts omitted. *See note.* By this modification, i. e. "by removing the bolt which secured the ends of the wheel-frame, the cutter frame was allowed to drop to the ground. Before this the wheel-frame carried the cutters, and to that end the frames had been, and according to the description given in the original patent, must be bolted together, and the conception of a machine which was not so bolted had not been in any manner indicated" therein.

"It will not do to say that it was the scope of the original patent, because the alteration was effected by the trifling change of removing the bolt. This is not the test. Many a useful and valuable invention has been made of a

NOTE.—Gosling, in his reissue has done the same.

device so simple and so seemingly trifling, that men wonder that it was not made before. The inquiry is, was such a device before known? and in this case, also, was this device for suffering the frame of the cutter to follow the ground in any manner indicated in Dinsmore's patent or specification, drawing or model? If not, then his patent does not and cannot be made legally to embrace it."

"Invention may be as necessary to reform or adapt an existing machine to the performance of work which it would not, as originally constructed, perform, as it is to make a new machine; and whether this is done by removing a device or by adding a new one, by removing a bolt or by inserting a bolt, by making an apparently great mechanical change or a small one, the principle governing the subject, is the same. The change being a substantial one, and producing a different result may, if it be new, be the subject of a new patent; but it is not to be covered by the reissue of an old one, which in no wise disclosed or suggested it, and especially when, in truth, the patentee had no conception of it when his patent was granted. Many an invention has come so near to a discovery and its application, that an apparently very slight change completes it and gives it great value, yet he never attained the result."

In order to enable the complainant's patent to cover respondent's devices, the complainant must not only omit something, i. e. the fastening of step and flange, but also go a step further and change the construction of his device by altering the mode of connection of plate to the door.

When complainant attempts to cover a device such as respondent's, he is attempting to render his reissue void on account of the lack of novelty, as there is no novelty in merely attaching a plate to a door as presented in Model B.

See Exhibit Ashenfelder's Patent, No. 8816, dated March 16, 1852, for Improvement in Omnibus step. See page 50 of Supreme Court Printed Record. *See note.*

Respondent's device is quite similar to the door of an omnibus. The door of an omnibus, it will be remembered, is provided at bottom with a curved or flat plate of wood or metal, covering, when the door is shut, the step or steps, and when the hind wheels project behind, i. e. beyond the rear of the body, serving as a wheel-fender when the door is open. We may expect to hear shortly of the complainant suing the makers and users of all such description of omnibusses.

COMPLAINANT'S DEVICE IS NOT MERITORIOUS NOR USEFUL.

The complainant's patented device is not a meritorious or useful invention. The elastic plate E, as attached to the step or frame work, does not act to any great extent as a spring to keep the door shut, when shut. Unless the door is

NOTE.—The idea of combining a rubber wheel-guard with a plate disconnected from step and rigidly fixed to door is new and belongs to Roberts, see his patent, page 52 of Record.

latched besides, it will rattle and flap and bang and open. (See testimony, F. C. Albrecht, ans. 11, page 27, of Supreme Court Printed Record. The plate E does operate to keep the door open, when opened, but this advantage is more than counterbalanced by the objection incident to such a connection—a portion of the clothing being exceedingly liable to become entangled in the narrow wedge-shaped opening between the step and the plate, and to be torn or to trip the wearer. It is in evidence and not rebutted (see Curtis' testimony, ans. 15 and 16, page 23 of Supreme Court Printed Record, *also ans.* 17, *page* 24, also X ans. 28, page 25, that the device represented by Model A is dangerous and inconvenient for ladies use; also, Albrecht, ans. 11 and 12, page 27, says Model A is an obstruction, rather than an advantage. He says also that he has taken Model A off of several carriages on account of the rattling and the tearing of dresses.

It is therefore submitted that in view of the state of the art, at the time the complainant invented his patented device, in view of the narrow scope and intendment of the complainant's original patent, in view of the vital differences between the complainant's patented device and that of the respondent, and that complainant's patent is not infringed, in view of the fact that a plate attached to the lower side of the door serving as a step-cover, and a combined step-cover and wheel-fenders were old at the time the complainant invented his

patented device, taking into consideration the fact that there is nothing meritorious or useful in the invention, but that it is an objectionable one, likely to result tn accident to those who buy or use a vehicle with such a device connected to it, that for the public weal complainant's *reissued* patent ought to be declared void, or at the best confined to the narrow limits it was originally designed to occupy.

Respectfully submitted,

Wm. Hubbell Fisher

Counsel for John Roberts, Appellee.